

THE HONORABLE BENJAMIN H. SETTLE

**IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF WASHINGTON  
AT TACOMA**

PACTOOL INTERNATIONAL LTD.,	)	<b>CASE NO. 3:06-cv-05367-BHS</b>
a Washington corporation,	)	
	)	<b>DEFENDANT KETT TOOL</b>
Plaintiff,	)	<b>COMPANY INC.'S OPENING CLAIM</b>
	)	<b>CONSTRUCTION BRIEF</b>
v.	)	
	)	<b>NOTE ON MOTION CALENDAR:</b>
KETT TOOL COMPANY INC., et al.	)	<b>March 18, 2011</b>
	)	
Defendants.	)	<b>ORAL HEARING REQUESTED</b>
	)	

Defendant Kett Tool Company Inc. ("Kett") submits this opening claim construction brief per the Court's Order [Doc. No. 143] dated January 21, 2011.

**I. CLAIM TERMS TO BE CONSTRUED**

The parties dispute the construction to be given several of the terms appearing in the two patents-in-suit, U.S. Patent No. 5,993,303 ("the '303 patent," copy attached as Exhibit 1) and U.S. Patent No. 6,250,998 ("the '998 patent," copy attached as Exhibit 2), along with their respective Reexamination Certificates, 5,993,303 C1 ("the '303 C1 Certificate") and 6,250,998 C1 ("the '998 C1 Certificate") (copies attached as Exhibits 3 and 4). The claims at issue are claims 2, 3, 4, 8, 11, 12, 16, 21, 23, 24 and 25 of the '303 patent and '303 C1

1 Certificate, and claims 1, 2, 3, 7, 10, 12, 13, 15, 16, 18, 19, 21, 22 and 24 of the '998 patent  
 2 and '998 C1 Certificate. A Joint Claim Chart identifying the disputed claim terms and the  
 3 parties' proposed construction of those terms was filed with the Court on February 25, 2011  
 4 [Doc. No. 164-1] and is attached hereto as Exhibit 5.

## 5 **II. LEGAL STANDARDS FOR CONSTRUING CLAIMS**

### 6 **A. The Claims Are The Primary Resource For Claim Construction**

7  
 8 In construing claims, the Court must look first to the language of the claims  
 9 themselves. *See, e.g. Middleton, Inc. v. Minnesota Mining & Mfg. Co.*, 311 F.3d 1384, 1387  
 10 (Fed. Cir. 2002). Both the asserted claims, and any claims that are not asserted, should be  
 11 considered. *Trading Techs. Int'l, Inc. v. eSpeed, Inc.*, 595 F.3d 1340, 1352 (Fed Cir. 2010)  
 12 ("In addition, 'other claims of the patent . . . can also be valuable sources of enlightenment as  
 13 to the meaning of a claim term.'"). *Id. (citing Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d  
 14 1576, 1582 (Fed. Cir. 1996)).

15  
 16 For purposes of claim construction, "the words of a claim 'are generally given their  
 17 ordinary and customary meaning...'” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir.  
 18 2005) (*en banc*) (*quoting Vitronics*, 90 F.3d at 1582). The ordinary and customary meaning  
 19 "is the meaning that the term would have to a person of ordinary skill in the art in question at  
 20 the time of the invention, *i.e.*, as of the effective filing date of the patent application.” *Id.* at  
 21 1313.

22  
 23 A claim construction that renders a claim term meaningless is improper. *See Cat*  
 24 *Tech LLC v. TubeMaster, Inc.*, 528 F.3d 871, 885 (Fed. Cir. 2008) (refusing to adopt a claim  
 25 construction which would render a claim limitation meaningless). Otherwise stated, if a  
 26 party proposes a claim construction that would make a claim term superfluous, it should not

1 be adopted. *Elekta Instrument S.A. v. O.U.R. Scientific Int'l, Inc.*, 214 F.3d 1302, 1305-07  
 2 (Fed. Cir. 2000) (refusing to adopt a claim construction which would render claim language  
 3 superfluous).

4 **B. The Specification Provides Context For The Invention And Claim Terms**

5 The claims, however, do not stand alone, and “must be read in view of the  
 6 specification of which they are a part.” *Phillips*, 415 F.3d at 1315 (*quoting Markman v.*  
 7 *Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (*en banc*), *aff’d*, 517 U.S. 370  
 8 (1996)). “[T]he specification is always highly relevant to the claim construction analysis.”  
 9 *Vitronics*, 90 F.3d at 1582. However,

11 it is improper to import limitations from the specification into  
 12 the claims where there is no indication that the specific  
 13 examples in the specification are intended to be strictly  
 14 coextensive with the claim.

15 *Phillips*, 415 F.3d at 1323; *see also Kinetic Concepts, Inc. v. Blue Sky Med. Group, Inc.*, 554  
 16 F.3d 1010, 1027 (Fed. Cir. 2009).

17 **C. The Prosecution History**

18 In addition to the claim language and the specification, the court may also consider  
 19 the patent’s prosecution history. *Phillips*, 415 F.3d at 1317. The prosecution history, which  
 20 is part of the “intrinsic evidence,” consists of the complete record of the proceedings before  
 21 the PTO and includes the prior art cited during the examination of the patent. *Id.* Because  
 22 the patentee creates the prosecution history in attempting to explain and obtain the patent,  
 23 “the prosecution history can often inform the meaning of the claim language by  
 24 demonstrating how the inventor understood the invention and whether the inventor limited  
 25 the invention in the course of prosecution, making the claim scope narrower than it would  
 26

otherwise be.” *Id.*

#### **D. Extrinsic Evidence Such As Dictionaries May Be Utilized**

Extrinsic evidence “consists of all evidence external to the patent and prosecution history, including . . . , dictionaries, and learned treatises.” *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed Cir. 1995), *aff’d*, 517 U.S. 370, 116 S. Ct. 1384, 134 L. Ed. 2d 577 (1996). A dictionary definition may be relied upon “so long as [it] does not contradict any definition found in or ascertained by a reading of the patent documents.” *Wavetronix v. EIS Elec. Integrated Sys.*, 573 F.3d 1343, 1355 (Fed. Cir. 2009) (*quoting Phillips*, 415 F.3d at 1322-23).

#### **E. Inventor Testimony Is Irrelevant**

Based on PacTool’s identification in the Joint Claim Chart (Exhibit 5) of extrinsic evidence in the form of deposition testimony and newly created Declarations from, among others, one of the named inventors on the patents-in-suit, this Court should be aware that such testimony is highly disfavored by the Federal Circuit. Kett will address this issue, and the specific improper evidence PacTool submits, when Kett files its Responsive Claim Construction Brief.

The Federal Circuit has “often repeated that inventor testimony is of little probative value for purposes of claim construction.” *E-Pass Techs. Inc. v. 3COM Corp.*, 343 F.3d 1364, 1370 n.5 (Fed. Cir. 2003). Some Federal Circuit panel opinions have gone so far as to declare inventor testimony “irrelevant” to claim construction. *See Cordis Corp. v. Boston Sci. Corp.*, 561 F.3d 1319, 1338 (Fed. Cir. 2009); *see also Hoechst Celanese Corp. v. BP Chems. Ltd.*, 78 F.3d 1575, 1580 (Fed. Cir. 1996) (“*Markman* requires us to give no deference to the testimony of the inventor about the meaning of the claims.”).

1 In *Markman v. Westview Instruments Inc.*, 52 F.3d 967, 983 (Fed. Cir. 1995) (en  
 2 banc), *aff'd*, 517 U.S. 370 (1996), the court found an inventor not competent to construe  
 3 patent claims, reasoning that:

4 Commonly the claims are drafted by the inventor's patent  
 5 solicitor and they may even be drafted by the patent examiner  
 6 in an examiner's amendment (subject to the approval of the  
 7 inventor's solicitor). While presumably the inventor has  
 8 approved any changes to the claim scope that have occurred via  
 9 amendment during the prosecution process, it is not unusual for  
 there to be a significant difference between what an inventor  
 thinks his patented invention is and what the ultimate scope of  
 the claims is after allowance by the PTO.

10 *Id.* at 985. Lending further support for excluding inventor testimony from claim  
 11 construction is the fact that it "is often a self-serving, after-the-fact attempt to state what  
 12 should have been part of his or her patent application." *Bell & Howell Document*  
 13 *Management v. Altek Sys.*, 132 F.3d 701, 706 (Fed. Cir. 1997); *see also Roton Barrier Inc. v.*  
 14 *Stanley Works*, 79 F.3d 1112, 1126 (Fed. Cir. 1996) ("We have previously stated that an  
 15 inventor's after-the-fact testimony is of little weight compared to the clear import of the  
 16 patent disclosure itself."). When construing a patent, a court is better served by evaluating  
 17 the claims and specification *objectively* from the perspective of one of ordinary skill in the  
 18 art, rather than relying on the *subjective* testimony of the inventor obtained in the context of  
 19 litigation. *See Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379-80 (Fed. Cir. 2000).

21 **F. The Accused Product Is Not To Be Considered In The Claim**  
 22 **Construction Analysis**

23 Finally, it is well-settled that the construction of patent claims is not dependent upon  
 24 the products accused of infringement. *Wilson Sporting Goods Co. v. Hillerich & Bradsby*  
 25 *Co.*, 442 F.3d 1322, 1330-31 (Fed. Cir. 2006) ("This court, of course, repeats its rule that  
 26

1 ‘claims may not be construed with reference to the accused device.’”) (*citing NeoMagic*  
 2 *Corp. v. Trident Microsystems*, 287 F.3d 1062, 1074 (Fed. Cir. 2002)). Thus, any attempt by  
 3 PacTool to consider the accused products in connection with claim construction is off base,  
 4 and in fact impermissible.

### 5 **III. THE DISPUTED TERMS OF THE ‘303 AND ‘998 PATENTS**

#### 6 **A. Overview Of The ‘303 Patent**

7  
 8 The ‘301 patent and ‘303 C1 Certificate, entitled “Hand-Held Cutting Tool For  
 9 Cutting Fiber-Cement Siding” issued on November 30, 1999 and December 1, 2009,  
 10 respectively. *See* Exhibits 1 and 3. The written description and 11 claims of the ‘303 patent  
 11 and ‘303 C1 Certificate disclose and claim a fiber-cement siding cutting tool. *Id.* Figures 1  
 12 and 3 of the ‘303 patent illustrate a cutting tool of the preferred embodiment of the ‘303  
 13 patent. *Id.*

#### 14 **B. Overview Of The ‘998 Patent**

15  
 16 The ‘998 patent and ‘998 C1 Certificate, entitled “Hand-Held Cutting Tool For  
 17 Cutting Fiber-Cement Siding,” issued on June 26, 2001 and December 8, 2009, respectively,  
 18 and claim priority back to the ‘303 patent. *See* Exhibits 2 and 4. Because the ‘998 patent is  
 19 related to the ‘303 patent as a continuation application, the disclosure of the ‘998 patent is the  
 20 same as the ‘303 patent and references herein to the specification of the ‘303 patent are  
 21 equally applicable to the ‘998 patent.

#### 22 **C. Grouping Of Claim Terms In Dispute**

23  
 24 Kett asserts that the claim terms and phrases listed in the Joint Claim Chart (Exhibit  
 25 5) should be grouped as follows for purposes of analysis and decision:  
 26

**Group I:** terms 1 and 2<sup>1</sup>;

**Group II:** terms 3-13; and

**Group III:** terms 14-17.

The bases for suggesting these groupings are that: 1) the Group I terms 1 and 2 (“gap” and “gap distance”) are very similar, Kett’s proposed definitions for these two terms are the same, and PacTool’s proposed definitions for these two terms are virtually identical (they differ only by a single word); 2) the Group II terms 3-13 all present the identical issues insofar as the parties’ dispute over the definitions are concerned, and thus resolution of the disputes as to those terms can be made with a single decision; and 3) the Group III terms 14-17 all present the issue of indefiniteness under 35 U.S.C. § 112.

#### **D. Support For Kett’s Proposed Definitions**

##### **1. Group I**

The dispute between the parties as to the proper construction of the Group I terms 1 and 2 essentially presents one issue: whether the degree or amount of separation between the inner surfaces of the two side knives needs to be defined with a frame of reference for determining the degree or amount of separation (i.e., as measured along a line perpendicular to the axes of the first and second fingers or guide members). Kett asserts that a proper construction does require such a frame of reference. Otherwise, the Group I terms are indefinite under 35 U.S.C. § 112.

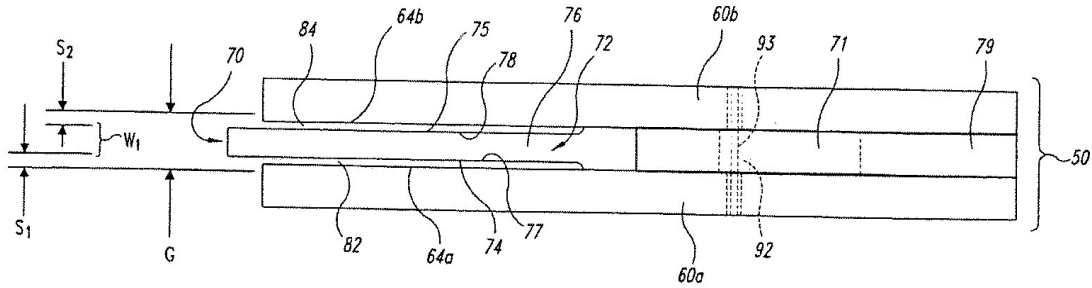
The Group I terms are “gap” and “gap distance” which are found in claims 8, 16, 21 and 25 of the ‘303 patent and claims 1, 2, 3, 7, 10, 13, 16, 19, and 22 of the ‘998 patent.

**A.** \_\_\_\_\_

<sup>1</sup> The reference to “term #” is taken from the left-hand column of the Joint Claim Chart (Exhibit 5).

**Kett's Proposed Construction:** "The degree of amount of separation between the first and second interior surfaces, as measured along a line perpendicular to the axis of the first and second fingers or guide members."

Figure 3 of the '303 and '998 patents (Exhibits 1 and 2), reproduced below for the convenience of the Court, identifies the "gap" or the "gap distance" by the letter "G."



*Fig. 3*

This "gap distance G" or "gap width G" is further explained in the respective specifications to be the distance "between the first interior surface **64a** of the first finger **60a** and the second interior surface **64b** of the second finger **60b**." Exhibit 1 at col. 4, ll. 13-15 and Exhibit 2 at col. 4, ll. 19-21. Accordingly, Kett's proposed claim construction language that reads, "... between the first and second interior surfaces . . .," is a virtual verbatim quotation from the specification.

Moreover, while the detailed descriptions for both the '303 and '998 patents refer to first and second "*fingers*" *id.*, the claims of the '998 patent refer to first and second "*members*" as opposed to "*fingers*." However, for the purposes of construing the term "gap" or "gap distance," this semantic variation is of no import. Accordingly, Kett's proposed claim construction language which further reads in relevant part, "... the first and second



1 fingers or guide members . . .,” is phrased in the disjunctive so that a single construction may  
 2 be applicable to the claims of both patents-in-suit.

3 Turning next to Kett’s proposed claim construction language which reads, “[t]he  
 4 degree of amount of separation between . . .,” Kett simply calls to the Court’s attention the  
 5 common dictionary definitions for a “gap” and a “distance.” For example a “gap” is often  
 6 defined as “a separation in space.” (Exhibits 6 and 7 at KETT 06754 & 06758.) And  
 7 “distance” is often defined as “the degree or amount of separation between” something.  
 8 (Exhibits 6-8 at KETT 06753, 06757, & 06761.) Hence, Kett’s proposed claim construction  
 9 language which reads, “[t]he degree of amount of separation between . . .,” is taken directly  
 10 from the common dictionary definitions for “gap” and/or “distance.”  
 11

12 Finally, turning to the frame of reference dispute between the parties’ respective  
 13 claim constructions, Kett’s proposed claim construction language, which reads in relevant  
 14 part, “. . . as measured along a line perpendicular to the axis of . . .,” is derived first again  
 15 from Figure 3 of the ‘303 and ‘998 patents (Exhibits 1 and 2). Here, to state the obvious, it is  
 16 unmistakable that the lines which define “G,” i.e., the “gap” or the “gap distance,” are  
 17 parallel to the axis of the first finger **60a** and the second finger **60b**. *Id.* Or said another way,  
 18 as Figure 3 illustrates, the two opposing arrows that define the “gap distance G” or “gap  
 19 width G” are perpendicular to the axis of the first finger **60a** and the second finger **60b**. *Id.*  
 20

21 The common dictionary definitions for “gap” and/or “distance” further reinforce  
 22 Kett’s proposed construction. For example, an example given of a “gap” is “the shortest  
 23 distance between the planes of the chords of the upper and lower wings of biplane.” (Exhibit  
 24 6 at KETT 06754) (emphasis added). Clearly, the shortest distance between the upper and  
 25 lower wings would be a line perpendicular to those wings.  
 26

1 Similarly, “distance” is further commonly defined as “the degree or amount of  
 2 separation between two points, lines, surfaces, or objects in geometrical space measured  
 3 along the shortest path joining them.” or as “the length of the perpendicular from a given  
 4 point to a given line.” (Exhibits 6, 8 and 9 at KETT 06753, 06761, & 06764) (emphasis  
 5 added).

6 Accordingly, Kett respectfully submits that the terms “gap” and “gap distance”  
 7 should be construed as “[t]he degree of amount of separation between the first and second  
 8 interior surfaces, as measured along a line perpendicular to the axis of the first and second  
 9 fingers or guide members.”

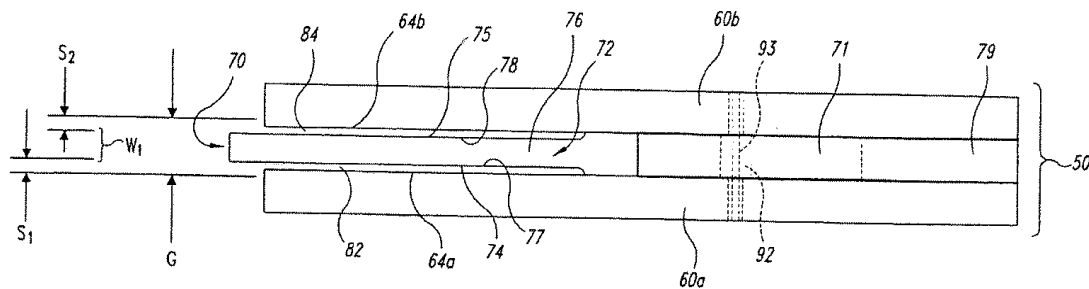
## 11 **2. Group II**

12 The dispute between the parties as to the proper construction of the Group II terms 3-  
 13 essentially presents two issues. The first issue is whether the recitation in these terms of  
 14 specific spacing dimensions needs to be defined with a frame of reference for determining  
 15 the recited spacing (i.e., as measured along a line perpendicular to the axis of the first and  
 16 second fingers or guide members). The second issue is whether such spacing dimensions  
 17 must be uniform along the length of the fingers or guide members (i.e., is there an inherent  
 18 requirement that the guide members or fingers have surfaces that are parallel to the side  
 19 surfaces of the center blade). As to the first issue, Kett asserts that the proper construction of  
 20 the Group II terms does require a frame of reference for determining the recited spacing.  
 21 Absent such a frame of reference, the Group II terms are indefinite under 35 U.S.C. §112.  
 22 As to the second issue, Kett asserts that there is no requirement, either explicit or implicit,  
 23 that the guide members or fingers have surfaces that are parallel to the side surfaces of the  
 24 center blade, i.e., the claims are not limited to spacing dimensions that are uniform along the  
 25  
 26

length of the fingers or guide members.

**a. A Proper Claim Construction Requires A Frame Of Reference**

Similar to the discussion in section D.1 above, Figure 3 of the '303 and '998 patents, reproduced below, identifies the distances or spacings between the first and second fingers, **60a** and **60b** respectively, and the center blade **70** as S1 and S2.



*Fig. 3*

Kett's proposed claim construction language which reads in relevant part, "... as measured along a line perpendicular to the axis of . . .," is derived first again from Figure 3 of the '303 and '998 patents (Exhibits 1 and 2). Here, to state the obvious, it is unmistakable that the lines which define "S1" and "S2", the separation or spacing distances are parallel to the axis of the first finger **60a** and the second finger **60b**. *Id.* Or said another way, as Figure 3 illustrates, the two opposing arrows that define "S1" and "S2" are perpendicular to the axis of the first finger **60a** and the second finger **60b**. *Id.*

The common dictionary definition for "distance" further reinforces Kett's proposed construction. For example, "distance" is commonly defined as "the degree or amount of separation between two points, lines, surfaces, or objects in geometrical space measured

1 along the shortest path joining them,” or as “the length of the perpendicular from a given  
 2 point to a given line.” (Exhibits 6, 8 and 9 at KETT 06753, 06761, & 06764) (emphasis  
 3 added).

4 Accordingly, Kett respectfully submits that the Group II terms must be construed  
 5 with a frame of reference in the form of the language “as measured along a line perpendicular  
 6 to the axis of the first and second fingers or guide members.” To construe these terms  
 7 without such a frame of reference for determining the dimension of the separation distance  
 8 flies in the face of the ordinary understanding for making such a measurement.  
 9

10 **b. A Proper Claim Construction Does Not**  
 11 **Require An Implicit Requirement Of Parallel**  
 12 **Surfaces**

13 The specifications of the ‘303 and ‘998 patents describe and depict an embodiment of  
 14 the claimed invention. Nowhere in the specifications, nor anywhere in the prosecution  
 15 histories of the patents-in-suit, nor in the reexamination prosecution histories is there a  
 16 requirement or explanation that calls for the fingers or guide members to have surfaces that  
 17 are parallel to the side surfaces of the center blade. Although Figure 3 of the ‘303 patent  
 18 shows an embodiment where those surfaces are parallel, there is no limitation in that regard.  
 19 It is well settled that it is improper to import limitations from the specification into the  
 20 claims.

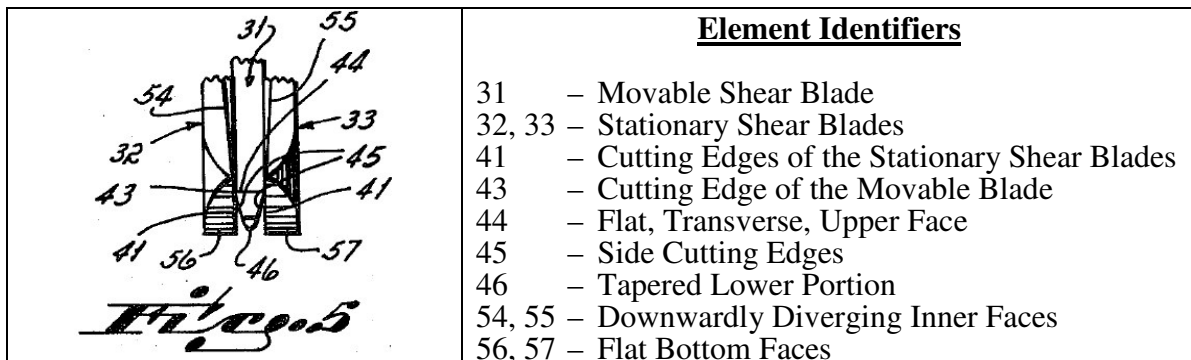
21 [I]t is improper to import limitations from the specification into  
 22 the claims where there is no indication that the specific  
 23 examples in the specification are intended to be strictly  
 coextensive with the claim.

24 *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (*en banc*) (*quoting Vitronics*,  
 25 90 F.3d at 1582); *see also Kinetic Concepts, Inc. v. Blue Sky Med. Group, Inc.*, 554 F.3d  
 26

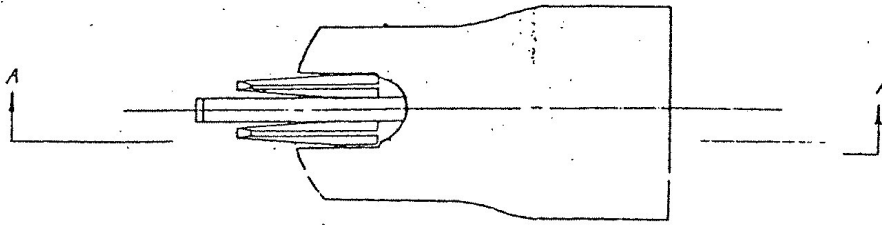
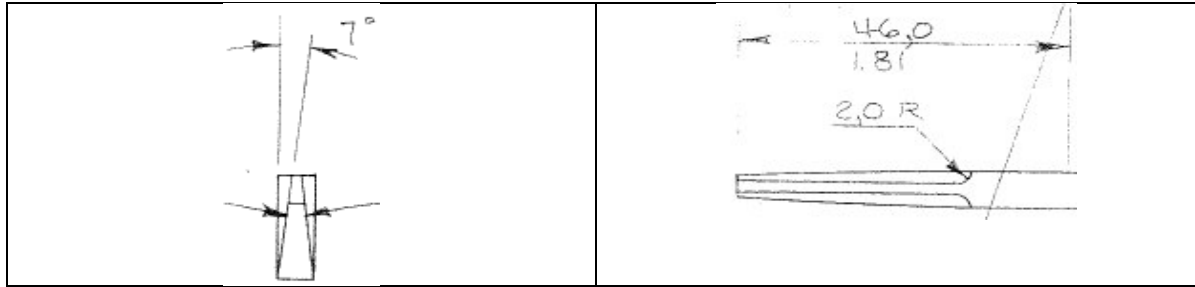
1010, 1027 (Fed. Cir. 2009).

The portion of the claim construction proposed by Kett “at any given point along that axis,” makes it clear that the claim is not limited to a parallel orientation of the respective surfaces. PacTool’s proposed construction of the Group II terms, on the other hand, imply there is such a parallel orientation limitation. This is improper under *Phillips*.

In further support of Kett’s proposed construction, the ‘303 patent incorporates by reference U.S. Patent No. 4,173,069. See Exhibit 1 at col. 3, lines 59-61. A copy of the ‘069 patent is attached as Exhibit 13. Reproduced below is Figure 5 of the ‘069 patent which shows a tapered center blade. Because the center blade is tapered, by definition the side surfaces of the center blade and the surfaces of the side shear blades are not parallel. Because the ‘069 patent is incorporated by reference in the ‘303 patent, it forms a part of the specification of the ‘303 patent.



Moreover, in the late 1970’s, Kett began working with James Hardie and Coy Pty. Ltd., an Australian company, to produce new shear blades to cut a new product – corrugated and flat cement fiber board. More specifically, the side knives (part no. 91-22) had a 7 degree taper, as shown in the figures below. The lower figure is an excerpt of Exhibit 12, KETT 02691.



These prior art shear blades are consistent with the proposed claim construction because they show that it was known in the art, prior to the inventions in the '303 and '998 patents, to have side knives and center blades without parallel facing surfaces.

PacTool itself has injected James Hardie into relevance through the Declaration of John T. Whitehead it filed with the USPTO during the reexamination proceedings on the '303 and '998 patents. *See* Exhibit 14 at ¶¶ 4 and 16. The prior products depicted above, manufactured for James Hardie, are thus relevant to the claim construction analysis and support the conclusion that it is improper to include a parallel orientation limitation in the claim terms at issue.

### 3. Group III

Terms 14-17 are grouped together because they all present the issue of indefiniteness under 35 U.S.C. § 112. It should be noted that these terms (and the claims in which they are found) are the partial subject of Kett's pending Motion for Summary Judgment (Dkt. No.

1 125) filed December 7, 2010. Although the Court stayed the briefing and decision on Kett's  
 2 motion, the indefiniteness analysis in that motion is highly relevant to the current claim  
 3 construction proceedings, and is reiterated below. Because claim terms that are indefinite are  
 4 not capable of construction, Kett has not proffered constructions for the Group III terms.

5 An indefinite patent claim is invalid. *See Amgen Inc. v. F. Hoffman-La Roche, Ltd.*,  
 6 580 F.3d 1340, 1371 (Fed. Cir. 2009) ("If a claim fails to reasonably apprise one skilled in  
 7 the art of the boundaries of the claim when read in light of the specification, then the claim is  
 8 invalid under § 112 for indefiniteness." (citing *Miles Lab., Inc. v. Shandon, Inc.*, 997 F.2d  
 9 870, 875 (Fed. Cir. 1993)). "Section 112(2) provides that '[t]he specification shall conclude  
 10 with one or more claims [1] particularly pointing out and distinctly claiming the subject  
 11 matter [2] which the applicant regards as his invention.'" *Veritas Operating Corp. v.*  
 12 *Microsoft Corp.*, Case No. 2:06-cv-703, 2007 U.S. Dist. LEXIS 98739, at \* 96 (W.D. Wash.  
 13 May 25, 2007) (quoting 35 U.S.C. § 112). Under this provision of the Patent Act, the  
 14 applicant is required to set forth what the invention is, and "must do so with sufficient  
 15 particularity and distinctness, *i.e.*, the claim must be sufficiently 'definite.'" *Id.* (quoting  
 16 *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1377 (Fed. Cir. 2000)). A party seeking  
 17 to invalidate a claim as indefinite under 35 U.S.C. § 112, ¶ 2 must show by clear and  
 18 convincing evidence that one skilled in the art would not understand the scope of the claim  
 19 when read in light of the specification. *Intellectual Prop. Dev., Inc. v. UA-Columbia*  
 20 *Cablevision of Westchester, Inc.*, 336 F.3d 1308, 1319 (Fed. Cir. 2003).

21 Indefiniteness is a question of law for the Court to decide. *See Honeywell Int'l, Inc.*  
 22 *v. United States*, 609 F.3d 1292, 1301 (Fed. Cir. 2010); *see also Exxon Research*, 265 F.3d at  
 23 1376 ("We adhere to the principle that 'determination of claim indefiniteness is a legal  
 24 conclusion that is drawn from the court's performance of its duty as the construer of patent  
 25 claims.'" (quoting *Personalized Media Commun., LLC v. United States Int'l Trade Comm'n.*,  
 26 161 F.3d 695, 705 (Fed. Cir. 1998)). Both the Federal Circuit and the courts in the Western

District of Washington have stated that indefiniteness is “inextricably intertwined with claim construction.” See e.g., *Energizer Holdings v. United States Int’l Trade Comm’n*, 435 F.3d 1366, 1367 (Fed. Cir. 2006) (emphasis added); *Atmel Corp. v. Information Storage Devices*, 198 F.3d 1374, 1379 (Fed. Cir. 1999); *Veritas*, 2007 U.S. Dist. LEXIS, at \*97 (W.D. Wash, May 25, 2007); *Omax Corp. v. Flow Int’l Corp.*, Case No. 04-cv-2334, 2006 U.S. Dist. LEXIS 81913, at \*11-12 (W.D. Wash. Nov. 7, 2006). Indeed, if after undertaking claim construction in full, the Court cannot determine the reasonable meaning of a claim term in dispute, then that term is indefinite. See *Datamize LLC v. Plumtree Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005).

**a. Claims Containing The Group III Phrases  
“to inhibit premature failure of said motor  
and drive assembly” And “to provide clean  
edge cuts” Are Indefinite**

“A claim is indefinite if its legal scope is not clear enough that a person of ordinary skill in the art could determine whether a particular composition infringes or not.” *Geneva Pharms., Inc. v. GlaxoSmithKline, PLC*, 349 F.3d 1373, 1384 (Fed. Cir. 2003) (citing 35 U.S.C. § 112); see also *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005) (claim must be “sufficiently precise to provide competitors with an accurate determination of the ‘metes and bounds’ of the protection involved”). Such is the case for claims containing the phrases “inhibit premature failure of said motor and drive assembly” and “to provide clean edge cuts.” The scope of these phrases are neither defined by the language of the specification, nor clear to a person of ordinary skill in the art.

The phrases exist in each of the independent claims of the ’303 patent, as they exist after reexamination. For example:

8. [The cutting tool of claim 7] A reciprocating  
fiber cement side cutting tool, comprising:

\* \* \*



1 a reciprocating cutting member between the first and  
2 second fingers . . .

3 the second width being less than the first width such  
4 that the first side surface is spaced apart from the first interior  
5 surface by 0.0425 to 0.045 inches and the second side surface  
6 is spaced apart from the second interior surface by 0.0425 to  
7 0.045 inches to ***inhibit premature failure of said motor and  
drive assembly and to provide clean edge cuts*** of said fiber-  
8 cement siding begin cut therebetween, . . .

9 (Exhibit 3) (emphasis added). In addition to claim 8 of the '303 patent, this phrase exists in  
10 the language of all remaining independent claims 16, 21 and 25, and therefore in all of the  
11 claims depending therefrom. (*See Id.* at 12-13). *See Wahpeton Canvas Co. v. Frontier*, 870  
12 F.2d 1546, 1552 n.9 (Fed. Cir. 1989) (noting that by definition dependent claims contain all  
13 the limitation of the independent claims from which they depend); *Markman v. Westview*  
14 *Instr.*, 52 F.3d 967, 1000 (Fed. Cir. 1995) (Newman, J., dissenting) ("An extensive body of  
15 law, statutory and judgemade, governs the construction and legal effect of patent claims; for  
16 example, that a claim is construed the same way in determining both patent validity and  
17 infringement; that a dependent claim includes all of the limitations of the independent  
18 claim..."). Accordingly, this indefinite limitation permeates all the claims of the '303 patent,  
19 and renders all the claims invalid.

20 Similar claim language is used in several claims of the '998 patent. In that patent,  
21 claims 7, 10, 13, 16, 19, and 22 include the phrases "to inhibit premature wear of the motor  
22 or the drive assembly" and "to provide even edge cuts along a fiber-cement workpiece cut by  
23 the cutting blade." For purposes of the Court's indefiniteness analysis, this phrase is  
24 sufficiently similar to the language of the '303 patent for the Court to determine their  
25 invalidity together.

26 Both phrases contain subjective components that render the claims indefinite. In the  
'303 patent, the term is "premature failing," while in the '998 patent, the term is "premature

1 wear.” The proper construction of each phrase depends upon a subjective reading of the  
 2 modifier “premature.” Likewise, in the ’303 patent, the term used is “clean edge cuts,” while  
 3 in the ’998 patent, the term used is “even edge cuts.” Despite the differences, proper  
 4 construction of each phrase depends on the subjective terms “clean” or “even.” Accordingly,  
 5 to the extent that the Court deems the claim language of the ’303 patent indefinite, the  
 6 language used in the ’998 patent is indefinite for similar reasons discussed below.

7 The role of the specification in determining indefiniteness was illustrated in *Datamize*  
 8 *v. Plumtree*, where the Federal Circuit considered the definiteness of the term “aesthetically  
 9 pleasing.” The court noted that “when faced with a purely subjective phrase like  
 10 ‘aesthetically pleasing,’ a court must determine whether the patent’s specification supplies  
 11 some standard from which to measure the scope of the phrase.” *Datamize*, 417 F.3d at 1351.  
 12 In *Datamize*, the patent’s specification referenced “aesthetically pleasing” by describing  
 13 various advantages of the invention over the prior art, including that it “enables the user  
 14 interface for each individual kiosk to be customized quickly and easily... adhering the...  
 15 interface to good standards of aesthetics and user friendliness.” *Id.* at 1351. Additionally,  
 16 the specification described that the size of buttons on the screen layout were predefined to a  
 17 size chosen [] to make them aesthetically pleasing in appearance...” *Id.* Ultimately, the court  
 18 held that “aesthetically pleasing” was indefinite because:

19 Datamize has offered no objective definition identifying a  
 20 standard for determining when an interface screen is  
 21 “aesthetically pleasing.” In the absence of a workable  
 22 objective standard, “aesthetically pleasing” does not just  
 include a subjective element, it is completely dependent  
 on a person’s subjective opinion.

23 *Id.* at 1350.

24 The specification of the ’303 patent does not illuminate the meaning of a “premature  
 25 failure” of the drive assembly and motor unit. The ’303 patent suffers from inadequacies  
 26 similar to those suffered by *Datamize*. Although, it does describe “premature failure” in the

1 prior art as “[o]ne drawback of the original hand-held tool” (Exhibit 1 at col. 2, lines 17-20),  
 2 the specification fails to provide one of ordinary skill in the art a means to measure when a  
 3 “failure” would be “premature.” Additionally, the ’303 patent describes its solution to the  
 4 problem, where “the inventors further discovered that increasing the size of the spaces...  
 5 between the blade... and the fingers... significantly reduced the premature failure of the  
 6 motor 24 and the drive assembly 36.” (*Id.* at col. 5, lines 25-29). And finally, “the blade set  
 7 50 of the cutting tool 10 not only provides a cost effective solution for reducing the  
 8 premature failure of the motor 24 and drive assembly 36, but it also produces a clean edge  
 9 along the cut.” (*Id.* at 51-54). But ultimately, the specification of the ’303 patent provides  
 10 “no objective definition identifying a standard” one of ordinary skill could use to determine  
 11 what is meant by “premature failure”.

12 Similarly, the specification offers no objective criteria to define a “clean edge cut.”  
 13 The term appears but twice in the specification: First, “it would be desirable to develop a  
 14 hand-held cutting tool that cuts a clean edge in FCS and is not subject to premature failure.”  
 15 (Exhibit 1 at col. 2, lines 34-36). Second, “the blade set 50 of the cutting tool 10 not only  
 16 provides a cost effective solution for reducing the premature failure of the motor 24 and drive  
 17 assembly 36, but it also produces a clean edge along the cut.” (*Id.* at col. 5, lines 51-54).  
 18 Like avoiding “premature failure,” the patent describes cutting a “clean edge” as an objective  
 19 of the claimed invention. However, one of ordinary skill in the art cannot, from the context  
 20 of the claims and specification, determine what either of those terms means.

21 This fact is illustrated, concisely – yet powerfully – by the deposition testimony of  
 22 Mr. Scott Fladgard, the named inventor of the ’303 patent. *See Phillips v. AWH*, 415 F.3d  
 23 1303, 1313 (Fed. Cir. 2005) (stating that it is a “well-settled understanding that inventors are  
 24 typically persons skilled in the field of the invention and that patents are addressed to an  
 25 intended to be read by others of skill in the pertinent art.”). Mr. Fladgard testified that he had  
 26 no idea what was meant by these terms:

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**Q.** Okay. And just after that second range is recited, it says, “to inhibit premature failure of said motor and drive assembly and to provide clean edge cuts of said fiber-cement siding being cut therebetween.” Do you see that?

**A.** Yes.

**Q.** So how is one to – to determine that premature failure of said motor and drive assembly has been inhibited?

\*\*\*

**A.** Give me the question again.

**Q.** How is one to determine whether premature failure of said motor and drive assembly has been inhibited or not?

\*\*\*

**A.** Subjective.

**Q.** Okay. And then how about “and to provide clean edge cuts of said fiber-cement siding cut therebetween”? What is the standard that’s applied to determine whether that gap width provides clean edge cuts?

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**A.** And again, that’s a subjective, as we talked about before: What’s a clean edge?

**Q.** Something might be clean to one person and not to somebody else?

**A.** Exactly.

(Scott Fladgard Dep. Tr. 118:9 – 119:12, previously filed with Dkt. 113-1, Ex. 3 to Davis Decl.). The terms “premature failing” and “clean edge cut,” by their nature, are subjective. What is meant by premature can only be understood by an objective understanding of when something – such as the failing of the motor and drive assembly – will or should likely happen. Likewise, whether a cut is a clean edge cut is based on an opinion. These terms

1 remain subjective without further description, discussion or definition. According to the  
 2 Federal Circuit in *Datamize*, that is where the specification must be used to determine  
 3 whether the construction of a purportedly indefinite term can be ascertained. As described  
 4 above, the '303 patent's specification provides one of ordinary skill in the art no further  
 5 guidance regarding the meaning of "premature failing" and "clean edge cut." Even the  
 6 named inventor cannot understand their meaning.

7 Accordingly, the Court should determine that the phrases "to inhibit premature failure  
 8 of said motor and drive assembly" and "to provide clean edge cuts" are indefinite, and  
 9 therefore, invalid.

10 **b. Claims Containing The Phrase "wherein the**  
 11 **first side spacing and the second side spacing**  
 12 **are from [a certain percentage] of a thickness**  
 13 **of a fiber cement workpiece" Are Indefinite**

14 "When a proposed construction requires that an artisan make a separate infringement  
 15 determination for every set of circumstances in which the [device] may be used, and when  
 16 such determinations are likely to result in differing outcomes (sometimes infringing and  
 17 sometimes not), that construction is likely to be indefinite." *Halliburton Energy Services,*  
 18 *Inc. v. M-I LLC*, 514 F.3d 1244, 1255 (Fed. Cir. 2008). The claims of the '998 patent reciting  
 19 that the first side spacing and the second side spacing are of a certain percentage of the  
 20 "thickness of a fiber-cement workpiece to be cut with the blade" require such a determination  
 21 from an artisan. Essentially, an artisan in the field must determine the ratio of the first and  
 22 second side spacing to the thickness of the fiber cement to determine whether his actions  
 23 constitute infringement.

24 This phrase generally exists in each of independent claim 2, 10, and 19 of the '998  
 25 patent, as they exist after reexamination. For example:

26 2. The method of cutting a fiber-cement workpiece  
 having a thickness of 0.025 inch, comprising:

\* \* \*

reciprocating a cutting blade between the first and second guide members and along a path transverse to the surface of the workpiece... ***wherein the first side spacing and the second side spacing are approximately 17% to 18% of a thickness of a fiber-cement workpiece;***...

(Exhibit 4 at col. 2, lines 12-15) (emphasis added). Because this limitation is contained in independent claims, it is by law included into the dependent claim thereof. *See Wahpeton Canvas*, 870 F.2d at 1552 n.9 (noting that by definition, dependent claims contain all the limitation of the independent claims from which they depend); *Markman*, 52 F.3d at 1000 (“An extensive body of law, statutory and judgemade, governs the construction and legal effect of patent claims; for example, that a claim is construed the same way in determining both patent validity and infringement; that a dependent claim includes all of the limitations of the independent claim...”).

In *Halliburton Energy Svs., Inc. v. M-I, LLC*, the Federal Circuit found claims such as those employed by PacTool invalid due to indefiniteness. *Halliburton Energy*, 514 F.3d at 1255. In this case, the court undertook the construction of “fragile gels” as used in a claim reciting “a method for conducting a drilling operation in a subterranean formation using a fragile gel drilling fluid.” *Id.* at 1246. The specification defined “fragile gels” in a number of ways, including: “easily disrupted or thinned, and that liquefies or becomes less gel-like and more liquid – like under stress...” *Id.* Among other considerations, the court found Halliburton’s claim indefinite because it failed to define the scope of the fragility of the gel in light of all the variables that go into the characteristics of the gels. *Id.* at 1253. Moreover, the court found that “an artisan would not know from one [oil] well to the next whether a certain drilling fluid was within the scope of the claims ...” and therefore infringed. *Id.* at 1254. *See also Geneva Pharms, Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 1384 (Fed. Cir. 2003) (determining that it is “the epitome of indefiniteness” that “a given embodiment

1 would simultaneously infringe and not infringe the claims, depending on the particular  
2 bacteria chose for analysis.”).

3       PacTool’s claims are similarly indefinite. To determine whether a particular device  
4 or use of a device infringes the claims of the ’998 patent identified above requires the artisan  
5 to make a repeated series of calculations of the percentage of the first and second side  
6 spacing with respect to the thickness of the workpiece he is currently dealing with. In other  
7 words, to determine whether a particular tool would arguably infringe these claims, you  
8 would have to first know the thickness of the particular workpiece in question. For one, or  
9 many thicknesses, the tool would not infringe, but the artisan in the field would not know  
10 (before calculating) from one piece of fiber-cement to the next whether the device he was  
11 using was within the scope of the claims; his same hand-held cutting tool would  
12 simultaneously infringe or not infringe, depending on the size of the workpiece. This is the  
13 “epitome of indefiniteness,” and as such, these claims are indefinite and invalid.

#### 14 **IV. CONCLUSION**

15       For all the foregoing reasons, Kett respectfully request that the Court adopt the  
16 constructions proposed by Kett as set out in Exhibit 5.

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**CERTIFICATE OF SERVICE**

I hereby certify that on March 4, 2011, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF system which will send notification of such filing to the following:

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